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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,037	06/23/2003	Kathiravan Sengodan	BEAS-01351US1	9533
23910	7590	11/20/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			STEELMAN, MARY J	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/602,037

Applicant(s)

SENGODAN, KATHIRAVAN

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/23/03, 09/22/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/22/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-10 are pending.

#### ***Information Disclosure Statement***

2. IDS received 09/22/2003 has been considered.

#### ***Specification***

3. The use of the trademark JAVA (and variations of JAVA) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner requests that Applicant amend page 1 of the Specification to fill in the blank lines.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears to Examiner that a system is claimed, while no elements or features of the claimed system are implemented in hardware. Claim limitations such as "a parser that parses" and a "command processor that converts" are directed towards an arrangement of software, per se.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See MPEP 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claims contain the trademark/trade name JAVA (JMS / JMX). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe byte code programming language and, accordingly, the identification/description is indefinite.

The trademark JAVA is improperly relied upon in the claims to incorporate the technical features of a particular programming language environment. However, the trademark JAVA can only properly define the source of the programming language environment, namely Sun Microsystems, Inc. Accordingly, the identification/description is indefinite.

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Sun Microsystems, Inc. is the sole producer and/or licensor of JAVA products. The trademark JAVA identifies the source of the products and not the products themselves. In contrast, for example, C++ is a name used in trade to identify a particular nonproprietary programming language conforming to an accepted standard. Products and services incorporating the name C++ are produced by numerous sources. Further, the technologies identified using the trademark JAVA are continuously evolving. An example of this evolution can be found in “JSR 14: Add Generic Types To The Java™ Programming Language”, which describes a proposed amendment to the JAVA Language Specification submitted by Sun Microsystems, Inc., in 1999 and pending approval by the JAVA COMMUNITY PROCESS Program. In view of the statements presented above, it is asserted that the trademark JAVA has no fixed definite technical meaning. Accordingly, a rejection under 35 U.S.C. 112, second paragraph, based on the use of the trademark JAVA as a limitation in a claim, is proper.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/601898, 10/602038, and 10/601929. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

In the instant application, 10/602037 Claims 1-10 are directed towards accessing JMS using a markup language, a source file containing markup language, parsing and communicating to a command processor and converting the markup language into JMS or JMX system operations.

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As an example:

10/601898 Claims 1-20 are directed towards a user entering markup languages and communicating to a remote server whereby a command processor converts the markup language into JMS or JMX system operations.

10/602038 Claims 1-18 are directed towards a user editing and modifying markup language programs that access JMS interfaces, parsing and communicating to a command processor, and a command processor that converts the markup language components into JMS or JMX system operations.

10/601,929, claims 1-14 are directed towards a user entering markup language components, a command processor that converts the markup language into JMS or JMX system operations, and communicates said markup language components to a server.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2003/0177477 A1 to Fuchs, in view of US Patent 6,753,889 B1 to Najmi.

Claim 1:

A system for accessing Java Message Service using a mark-up language, comprising:

-a source file that contains one or more markup language components;

Fuchs: [0155-0158]-“The Mbean classes or descriptors 2501A to 2501C may correspond e.g. to existing predefined M beans having commonly used management features...Mbeans may be: standard Mbeans written in JAVA....Mbeans obtained through UML modeling...Model Mbeans, defined e.g. using XML descriptors (markup language components).” Source file containing Mbeans defined using XML descriptors are processed by the engine to produce output [0163]. See FIG. 5, [0178-0187]. Generated MIBs 510 and Generated XML Mapping Description 520 are input to FIG. 6, as a source file.

-a parser that parses said source file and communicates said markup language components to a command processor;

Fuchs: See FIG. 6, #600, #620, and #615 and related text at [0212-0221]. Source input is parsed and communicated to steps 630-646 (command processor).

Fuchs disclosed a command processor at [0212-0220]. Default mapping as defined by JDMK is applied, suggestive of JMX. Fuchs failed to explicitly disclose:



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-a command processor that converts the markup language components into one of JMS or JMX system operations.

However, Najmi disclosed (col. 10:3)-“receiver message adapter (command processor) to convert the response message to appropriate message format...” See Figs. 4, 7A, 7B and related text at col. 9: 28 through col. 10: 13. Najmi disclosed JMS messages.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Fuchs, using the teachings of Najmi, because both inventions are directed towards transparent protocols (Fuchs: [0004] & Najmi: col. 2:12-22) for enterprise messaging using JAVA messaging services.

Per claim 2:

-said parser and said command processor comprise an engine that parses source files and generates commands.

Fuchs: See FIG. 6. Inputs 2510 and 2520 are parsed (at 600). Commands are generated at 660.

Per claim 3:

Fuchs failed to explicitly disclose:

-the markup language is JMS markup language.

However, Najmi disclosed JMS (Col. 10: 43) as a message handler.

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Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Fuchs, with the teachings of Najmi, because both inventions are directed towards transparent protocols (Fuchs: [0004] & Najmi: col. 2:12-22) for enterprise messaging using JAVA messaging services.

Per claim 4:

-the source file is an XML file.

Fuchs: See FIG. 6, #2520 & #642.

Per claim 5:

-the markup language is JMS markup language.

See rejection of limitations addressed in claim 3 above.

Per claim 6:

A method for accessing Java Message Service using a mark-up language, comprising the steps of: supplying a source file, wherein said source file contains one or more markup language components; passing said source file as input to a parser, wherein said parser identifies said markup language components and passes said markup language components to a command processor; and, translating, by said command processor, the markup language components into one of JMS or JMX system operations.

See rejection of limitations addressed in claim 1 above.

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Per claim 7:

-said parser and said command processor comprise an engine that parses source files and generates commands.

See rejection of limitations addressed in claim 2 above.

Per claim 8:

-the markup language is JMS markup language.

See rejection of limitations addressed in claim 3 above.

Per claim 9:

-the source file is an XML file.

See rejection of limitations addressed in claim 4 above.

Per claim 10:

-the markup language is JMS markup language.

See rejection of limitations addressed in claim 5 above.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The

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examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

11/07/2006

*Mary Steelman*  
*Primary Examiner*